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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91199752
Party	Plaintiff Evonik Degussa GmbH
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	04/17/2012
Attachments	TRADEMARK 1.PDF ( 12 pages )(138258 bytes )

In the Matter of Application Serial Nos. 85/096,047 and 79/083,600

Afgritech Ltd.

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**EVONIK DEGUSSA GMBH'S MOTION FOR LEAVE TO AMEND  
AND SUPPORTING MEMORANDUM**

Evonik filed the instant Opposition No. 91199752 on May 11, 2011 on the grounds that Afgritech's intended use of the AMINOGREEN Mark would cause confusion with Evonik's

AMINORED mark, which is the subject of Evonik's Application Serial No. 79/083,600 (the "AMINORED Mark"). However, in the course of conducting discovery on the question of likelihood of confusion between the AMINOGREEN Mark and the AMINORED Mark, Evonik learned that Afgritech did not have a "*bona fide* intent" to use the AMINOGREEN Mark in commerce, as is required under 15 U.S.C. § 1052(b). Specifically, Afgritech disclosed such lack of a bona fide intent to Evonik in its "Objections and Responses to Opposer's First Set of Requests for Production of Documents" and "Objections and Responses to Opposer's First Set of Interrogatories to Applicant," both of which Afgritech served on December 21, 2011, and in its "Answers to Evonik's First Set of Requests for Admission to Applicant," which Afgritech served on March 2, 2012. Evonik is contemporaneously filing its Motion for Summary Judgment, in which it explains in detail the manner in which Afgritech's discovery responses demonstrate that Afgritech lacked the requisite bona fide intent to use the AMINOGREEN Mark when it filed its Application Serial No. 85/096,047. But in order for the Board to rule on that motion, it must first grant Evonik leave to amend its Notice of Opposition to add this newly discovered claim.

Under TBMP § 507.02 and FED. R. CIV. P. 15(a), unless a party seeks to amend its pleading within 21 days of serving it or with the consent of the adverse party (neither of which applies here), it must move for leave to amend. Leave should be freely given when justice so requires. *E.g.*, TBMP § 507.02; FED. R. CIV. P. 15(a)(2). Accordingly, the Board should liberally grant leave to amend pleadings at any stage of a proceeding when justice so requires (unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party); this is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original opposition. *E.g.*, TBMP § 507.02.

Applying these general rules to the specific factual context here, the Board has *repeatedly* allowed opposers to amend their notices of opposition to add a claim that a challenged application was void *ab initio* for lack of a “bona fide intent” to use under 15 U.S.C. § 1052(b), even when such a claim was not included in the original notice of opposition. *E.g., SmithKline Beecham Corp. v. Omnisource DDS LLC*, 97 U.S.P.Q.2d 1300, 1301 (T.T.A.B. 2010); *Saul Zaentz Co. v. Bumb*, 95 U.S.P.Q.2d 1723, 1724 (T.T.A.B. 2010); *Research in Motion Ltd. v. NBOR Corp.*, 92 U.S.P.Q.2d 1926, 1928 (T.T.A.B. 2009); *Honda Motor Co. v. Winkelmann*, 90 U.S.P.Q.2d 1660, 1661 (T.T.A.B. 2009); *Boston Red Sox Baseball Club LP v. Sherman*, 88 U.S.P.Q.2d 1581, 1583 (T.T.A.B. 2008); *L.C. Licensing Inc. v. Berman*, 86 U.S.P.Q.2d 1883, 1885 (T.T.A.B. 2008); *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1507 (T.T.A.B. 1993). The reasoning behind the Board’s willingness to grant leave to amend in such cases is clear: the facts surrounding the “*bona fides*” of an applicant’s intent to use a mark can *only* be uncovered in discovery; there is no practical way for an opposer to plead such a claim *without* having first conducted discovery:

If a lack of a *bona fide* intent to use is found, the application will be deemed invalid. Frequently, however, an opposer will not have a sufficient factual basis for asserting such a ground until discovery is obtained that reveals the apparent lack of a bona fide intent to use.

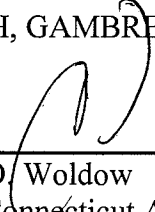
Sandra Edelman, *Proving Your Bona Fides – Establishing Bona Fide Intent to Use under the U.S. Trademark (Lanham) Act*, 99 TRADEMARK REP. 763, 769 (May-June 2009).

The same reasoning applies equally in this case. Like the opposers in the foregoing cases, Evonik set out to prove that there was a likelihood of confusion between its AMINORED Mark and the AMINOGREEN Mark. But like those same opposers, in so doing it discovered that Afgritech had absolutely no documents or things to substantiate or corroborate its supposed bona fide intent to use the AMINOGREEN Mark. There is no question that Evonik’s Opposition

No. 91199752 must be sustained – and Afgritech's Application Serial No. 85/096,047 must be refused – on this ground alone. Thus, this case presents the quintessential example of a case where justice requires that leave to amend be granted. Evonik's Motion for Leave to Amend its Notice of Opposition must be granted.

Respectfully submitted this 1<sup>st</sup> day of April, 2012.

SMITH, GAMBRELL & RUSSELL, LLP



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032301.691OPP 9442682.2

In the Matter of Application Serial Nos. 85/096,047 and 79/083,600

V.

Opposition No. 91199752 (parent)  
Opposition No. 91200334

I, Scott D. Woldow, counsel for Evonik Degussa GmbH, do hereby certify that EVONIK DEGUSSA GMBH'S MOTION FOR LEAVE TO AMEND was on this day served upon Afgritech Ltd. pursuant to 37 C.F.R. § 2.119(b)(4) by first-class mail, addressed as follows:

Pursuant to 37 C.F.R. § 2.119(b)(6) and to the July 21, 2011 letter between counsel for Evonik and Afgritech, a courtesy copy was also sent by email.

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Scott D. Woldow

In the Matter of Application Serial Nos. 85/096,047 and 79/083,600

V.

Opposition No. 91199752 (parent)  
Opposition No. 91200334

In the matter of the application of Afgritech Ltd. (hereinafter “Applicant”), for registration of the mark AMINOGREEN, filed on July 29, 2010, application Serial No. 85/096,047, published in the Official Gazette on January 11, 2011, Evonik Degussa GmbH (hereinafter “Opposer”), a Limited Liability Company of the Federal Republic of Germany, having offices at Rellinghauser Strasse 1-11, Essen, D-45128, Germany, believes that it will be damaged by registration of the AMINOGREEN mark shown in Serial No. 85/096,047, and hereby opposes the same.

1. Opposer is now and has been engaged in the specialty chemical business.

2. Opposer is the owner of the AMINORED trademark application, Serial No.

79/083,600, which is pending in association with:

Chemicals used in industry and science, as well as in agriculture, horticulture and forestry except for fungicides, herbicides, insecticides, and parasiticides;

chemicals for use in industry; Chemicals used in industry, namely, chemicals for industrial purposes; chemicals for use in industry and science; chemical substances for preserving foodstuffs.

**International Class: 009**

Computer software for use in estimating amino acid content in feedstuff for livestock and in formulating livestock diets in the field of animal nutrition; Diagnostic apparatus for testing feed ingredients; Measuring apparatus, namely, technical measuring, testing and checking apparatus and instruments for measuring, testing and checking feed ingredient raw material and rapid evaluation of digestibility in heat processed raw materials; Testing and food analysis apparatus, namely, apparatus for testing gas, liquid and solids for feed ingredient analysis; Testing and food analysis apparatus, namely, apparatus for testing gas, liquid and solids to detect heat damage in a processed raw material and to adjust amino acid digestibility in order to prevent performance depression of animals fed ingredients; Testing and food analysis apparatus, namely, apparatus for testing animal nutrition liquids and solids; Testing and food analysis apparatus, namely, apparatus for testing gas, liquid and solid raw materials for amino acid content; Scientific instruments, namely, electronic analyzers for testing feed ingredient raw material quality.

**International Class: 031**

Foodstuffs for animals; additives to fodder, not for medical purposes.



**International Class: 041**

Education and instruction, namely, conducting conferences, congresses, symposiums and colloquiums in the field of feedstuff and animal nutrition; entertainment in the nature of conducting entertainment exhibitions in the nature of animal exhibitions and animal nutrition festivals; teaching and continuing professional education for experts in the field of feedstuff and animal nutrition; arranging and conducting of conferences, congresses, symposiums and colloquiums in the field of animal nutrition and feedstuff; organization of exhibitions for cultural and/or educational purposes; publication of books, newspapers and periodicals; arranging and conducting of seminars and workshops, especially for experts in field of animal nutrition.

**International Class: 042**

Scientific and technological services and research and design in the field of animal nutrition, feedstuff, and chemicals; industrial analysis and research services in the field of animal nutrition and feedstuff; design and development of computer hardware and software, in particular computer programs, especially as a database for amino acid analysis in feedstuffs for animal nutrition; computer software consultancy; technical consulting services for the animal feed industry about scientific research in the use of animal feed ingredients; chemistry consulting services; bacteriological and/or chemical laboratory research services; physics research; Research, namely, materials testing, analyzing, and evaluation; Industrial analysis, namely, product testing; Scientific and technological services, namely, scientific research, analysis and testing in the fields of feed ingredient

raw material and amino acid digestibility; Research, namely, testing of raw materials and feed additives; Industrial analysis, namely, testing or research on machines, apparatus and instruments for raw materials and feed additives.

3. Opposer's AMINORED trademark application was filed on April 10, 2010 with a priority date claim of December 8, 2009.

4. Opposer had and continues to have a bona fide intent to use the AMINORED mark in commerce in association with the goods and services listed in the trademark application.

5. Opposer's mark is symbolic of goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising and promotion.

6. Notwithstanding Opposer's rights in and to its AMINORED mark, Applicant on July 29, 2010, filed an application for registration of the mark AMINOGREEN. The AMINOGREEN trademark was approved for publication in association with "animal feed supplement", in Class 5 and "livestock feed", in Class 31. The application was assigned Serial No. 85/096,047 and was published for opposition in the Official Gazette of January 11, 2011.

7. Applicant's mark AMINOGREEN, when used in connection with the goods set forth in its application, is confusingly similar to Opposer's AMINORED mark, as set forth and protected by Opposer's above-identified prior pending application. Registration and use of Applicant's mark in association with the products identified in the trademark application is likely to cause consumer confusion, mistake and deception.

8. Applicant's mark and Opposer's mark are highly similar in appearance, sound, connotation and commercial impression.

9. The goods associated with the AMINOGREEN mark and the goods and services associated with the AMINORED mark are highly similar.

10. Despite Opposer's rights in and to the AMINORED mark, Applicant proposed the AMINOGREEN designation to refer to its products. Both the AMINORED mark and the AMINOGREEN mark are associated with animal food products. The similar nature of the goods accentuates the similarity between AMINORED and AMINOGREEN and exacerbates the likelihood of confusion regarding the marks and the likelihood of confusion as to sponsorship or affiliation.

11. If Applicant is permitted to register its AMINOGREEN mark, and uses the mark in commerce, for the goods specified in the application, confusion in the trade resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between Applicant's mark and Opposer's mark. Persons familiar with Opposer's mark would be likely to confuse Applicant's goods as a product made, sold, or sponsored by Opposer. Any such confusion in the trade would inevitably result in loss of sales to Opposer.

12. In addition to the harm identified in the preceding paragraph, any defect, objection or fault found with Applicant's products marketed under the AMINOGREEN mark would necessarily reflect badly upon and significantly injure the reputation which Opposer has established for its products.

13. Attached are true copies of United States Patent and Trademark Office database reports showing current title and status of Opposer's prior pending application.

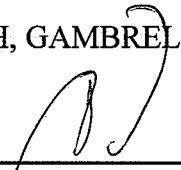
14. In addition to the foregoing, Applicant did not have a bona fide intention to use the AMINOGREEN mark in commerce on the specified goods when it filed its Application Serial No. 85/096,047 on July 29, 2010. Accordingly, under 15 U.S.C. § 1052(b), Application Serial No. 85/096,047 is void.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's mark, and prays that registration be denied.

Please charge Deposit Account No. 02-4300 for any additional fees that may be required.

Respectfully submitted this 17<sup>th</sup> day of April, 2012.

SMITH, GAMBRELL & RUSSELL, LLP



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I, Scott D. Woldow, counsel for Evonik Degussa GmbH, do hereby certify that EVONIK DEGUSSA GMBH'S AMENDED NOTICE OF OPPOSITION was on this day served upon Afgritech Ltd. pursuant to 37 C.F.R. § 2.119(b)(4) by first-class mail, addressed as follows:

Pursuant to 37 C.F.R. § 2.119(b)(6) and to the July 21, 2011 letter between counsel for Evonik and Afgritech, a courtesy copy was also sent by email.

Scott D. Woldow